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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,938	01/20/2000	HEIKO DASSOW	2345/101	7873
26646 7590 05/04/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER BOUTAH, ALINA A				
ART UNIT 2443		PAPER NUMBER		
MAIL DATE 05/04/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/403,938

**Applicant(s)**

DASSOW ET AL.

**Examiner**

ALINA N. BOUTAH

**Art Unit**

2443

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12, 15-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 15-22, 23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CC)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to Applicant's amendment filed March 2, 2009. Claims 13, 14 and 24 have been cancelled. Claims 12, 15-22, 23 and 25 are pending in the present application.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 2, 2009 has been entered.

### ***Claim Objections***

Claims 15 and 16 depend on canceled claim 14. Correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12, 15-23 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 12, 15-23 and 25 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The steps in the method are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 15-17, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,278,955 issued to Forte et al. (hereinafter referred to as Forte) in view of USPN 5,966,663 issued to Gleason.

Regarding claim 12, Forte teaches a method for transmitting information, comprising the steps of:

using a data structure that is defined by a formal language called Abstract Syntax Notation One (col. 8, lines 9-12 and lines 59-60; col. 10, lines 5-10); transmitting the information encoded as plain text (figure 8; col. 9, lines 19-63); and transmitting a designation of a data type with each piece of the transmitted information, the designation of the data type being defined by the formal language called Abstract Syntax Notation One (col. 8, lines 9-12 and lines 59-60; col. 10, lines 5-10).

However, Forte does not explicitly teach wherein the encoded text is decodable without accessing a reference to an internal Abstract Syntax Notation One definition.

In an analogous art, Gleason teaches an encoded text being decodable without accessing a reference to an internal Abstract Syntax Notation One definition (col. 22, lines 16-31). At the time the invention was made, one of ordinary skill in the art would have been motivated to decode text without accessing a reference to an internal Abstract Syntax Notation One definition because this mechanism is well known, easily implemented, and inexpensive (col. 22, lines 25-29).

Regarding claim 15, Forte teaches the method according to claim 14, wherein the step of transmitting the designation includes the steps of placing the designation in front of each piece of the transmitted information and separating the designation from each piece of the transmitted information by a predefined separator character (col. 11, lines 11-18).

Regarding claim 16, Forte teaches the method according to claim 15, wherein the step of separating the designation includes the step of separating the designation from each piece of the transmitted information by an equal sign (col. 11, lines 18, 23-24 and 28-29).

Regarding claim 17, Forte teaches the method according to claim 12, further comprising the step of: outputting a form of the encoded information by using a standard, readily available output facility (col. 2, lines 4-36).

Regarding claim 20, Forte teaches the method according to claim 12, further comprising the step of: creating an e-mail interface for transmitting the text-encoded information (figure 8A).

Regarding claim 22, Forte teaches the method according to claim 12, further comprising the steps of: automatically encoding and sending management information (col. 8, lines 59-60); and automatically receiving and decoding the management information (col. 12, lines 16-35).

Claims 18, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte in view of Gleason, in further view of Goumillou (U.S. Patent No. 5,836,008).

In considering claim 18 and 19, while Forte discloses the system substantially as claimed Forte does not disclose transmitting encoded information between a subscriber and a public telecommunications network, wherein the encoded information relates to management of public telecommunication networks and is transmitted via Common Management Information Protocol. Nonetheless, information transmission of telecommunications networks based on CMIP is well known as evidenced by Goumillou. In similar art, Goumillou discloses a system for transmitting information between a source and a receiver via a network connected to telecommunications equipment. Goumillou also discloses wherein the telecommunications equipment comprises for the internal transmission of management messages communication means based upon the Common Management Information Protocol (CMP). Thus a person having ordinary skill in the art would have recognized the desirability of including the information transmission based on the CMP in the telecommunication networks because the protocol governs the information management of telecommunications equipment. Therefore, the aforementioned limitation would have been an obvious modification to the system disclosed by Forte.

Claim 23 has substantially the same limitation as those in claims 12, 19 and 20, therefore rejected under the same rationale.

Claim 24 has substantially the same limitation as those in claims 12, 19 and 20, therefore rejected under the same rationale.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forte in view of Gleason, in further view of Rigori (U.S. Patent No. 5,892,930).

In considering claim 21, Rigori further discloses the method further comprising the step of using encoding tables, the encoding tables being adaptable to character sets of transmitting systems (col. 5. lines 7-10).

### ***Response to Arguments***

Applicant's arguments have been considered but are not found persuasive.

In response to Applicant's argument that Forte and Gleason do not teach the present invention, the PTO respectfully disagrees and submits that Forte and Gleason combined, does teach the claimed invention as cited above.

In response to Applicant's argument that Forte and Gleason references do not teach using an ASN.1 data structure, and via encoded text, and then read such text without accessing any internal definitions, the PTO respectfully disagrees and submits that this is taught by Forte combined with Gleason as cited above. For example, Forte teaches using an ASN.1 data structure, and via encoded text in col. 8, lines 9-11 and lines 59-60, which recites "block 102 indicates the conversion from ASCII text to abstract syntext notation version 1 ASN.1 protocol data units and further submits this data to message transfer agent 24."



In an analogous art, Gleason teaches "the encoded text being decodable without access to an internal Abstract Syntax Notation One definition," see col. 22, lines 23-26 which discloses that "all that is needed is a relatively simple ASCII character-to-binary symbol encoding at the send end and a binary symbol decoder-to-ASCII character decoding at the receiving end." The fact that the character can be decoded simply by using decoder-to-ASCII implies that it does not need to access Abstract Syntax Notation One definition as claimed.

The rest of the claims depend directly or indirectly from claim 12, therefore are rejected as being dependent on rejected claim.

### ***Conclusion***

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and non-preferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PTO-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALINA N. BOUTAH whose telephone number is (571)272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L.M. Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alina N Boutah/  
Primary Examiner, Art Unit 2443